

REMARKS

The present application was filed on July 24, 2003 with claims 1 through 32. Claims 1-19 and 21-32 are presently pending in the above-identified patent application. Claims 1, 19 and 24 are proposed to be amended.

In the Office Action, the Examiner rejected claims 9, 18, 19 and 32 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that applicant regards as the invention.

Claims 1, 10 and 24 were rejected under 35 U.S.C. §102(b) as being anticipated by Helgeson (United States Patent No. 6,643,652) in view of Fernandez (United States Patent No. 6,785,673). In addition, claims 2 and 25 were rejected under 35 U.S.C. §103(a) as being unpatentable over Helgeson in view of Fernandez (United States Patent No. 6,785,673). Claims 2 and 25 were rejected under 35 U.S.C. §103(a) as being unpatentable over Helgeson in view of Fernandez, and further in view of Chau et al. (United States Publication No. 2002/0123993). Claims 3, 11 and 26 are rejected under 35 U.S.C. §103(a) as being unpatentable over Helgeson, in view of Fernandez and in further view of Jones (United States Publication No. 2004/010754) and further in view of O'Carroll (United States Patent No. 6,772,165). Claims 6, 8, 15, 17, 23 and 29 were rejected under 35 U.S.C. §103(a) as being unpatentable over Helgeson, in view of Fernandez, Jones and O'Carroll and further in view of Bernstein et al. (United States Patent No. 6,826,568) and in further view of Mani et al. (United States Patent No. 6,654,734). Claims 9, 18 and 32 were rejected under 35 U.S.C. §103(a) as being unpatentable over Helgeson, in view of Fernandez and in further view of W3C ("XSL Transformation (XSLT), Version 1.0).

Claims 4-5, 7, 12-14, 16, 21-22, 27-28 and 30-31 were indicated to be allowable if rewritten in independent form. Claims 19 and 21-22 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. §112, 2nd paragraph.

Section 112

Claims 9, 18, 19 and 32 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that applicant regards as the invention. Claims 1, 19 and 24 have been amended to provide proper antecedent basis for a number of terms.

"Substantially Similar "

With regard to claims 9, 18 and 32, the Examiner has asserted that the terms "substantially" and "similar" are relative terms that render the claims indefinite. Applicants respectfully traverse the rejection for at least the following reasons

The Examiner appears to argue that terms "substantially" and "similar" are relative terms and therefore *per se* indefinite. However, there is no legal support whatsoever for the position that the mere use of some particular term automatically renders the corresponding claims indefinite. In fact, the Court of Customs and Patent Appeals, the predecessor to the Federal Circuit, is directly contrary to such a position in the context of Section 112, second paragraph. In re Venezia, 189 USPQ 149, (CCPA 1976).

First, Applicants points out that M.P.E.P. §2173.05(b) states:

When a term of degree is presented in a claim, first a determination is to be made as to whether the specification provides some standard for measuring that degree. If it does not, a determination is made as to whether one of ordinary skill in the art, in view of the prior art and the status of the art, would be nevertheless reasonably apprised of the scope of the invention. Even if the specification uses the same term of degree as in the claim, a rejection may be proper if the scope of the term is not understood when read in light of the specification. *While, as a general proposition, broadening modifiers are standard tools in claim drafting in order to avoid reliance on the doctrine of equivalents in infringement actions*, when the scope of the claim is unclear a rejection under 35 U.S.C. 112, second paragraph, is proper. See In re Wiggins, 488 F.2d 538, 541, 179 USPQ 421, 423 (CCPA 1973).

When *relative terms are used in claims wherein the improvement over the prior art rests entirely upon size or weight of an element in a combination of elements*, the adequacy of the disclosure of a standard is of greater criticality.

Further, subsection (D) of M.P.E.P. §2173.05(b) goes on to state:

The term "substantially" is often used in conjunction with another term to describe a particular characteristic of the claimed invention. It is a broad term. In re Nehrenberg, 280 F.2d 161, 126 USPQ 383 (CCPA 1960). The court held that the limitation "to substantially increase the efficiency of the compound as a copper extractant" was definite in view of the general guidelines contained in the specification. In re Mattison, 509 F.2d 563, 184 USPQ 484 (CCPA 1975). The court held that the limitation "which produces substantially equal E and H plane illumination patterns" was definite because one of ordinary skill in

the art would know what was meant by "substantially equal " Andrew Corp. v. Gabriel Electronics, 847 F.2d 819, 6 USPQ2d 2010 (Fed. Cir. 1988).

The standard of interpretation thus looks first toward the specification. Applicants respectfully direct the Examiner to the present specification at page 3, lines 12-15, for example, where it is noted that "when the modified view query is evaluated on a relational database instance, the *same* XML document is obtained as would be obtained by evaluating the XSLT stylesheet on the original XML view. See also, page 5, lines 18-20. The above passages are just some examples of parts of the specification that give definition to the phrase "substantially similar."

Thus, where (i) the broadening modifiers are employed to avoid reliance on the doctrine of equivalents in infringement actions, and (ii) the improvement over the prior art in no way rests upon the size or weight of an element in a combination of elements, the use of such broadening modifier should not be found to be indefinite. *Cf.* M.P.E.P. §2173 05(b)

The scope of claims 9, 18 and 32 would be interpreted by a person of ordinary skill in the art to cover situations where the obtained XML document is the *same as* a second XML document produced by applying said XSLT stylesheet on said XML document produced by said initial view query, *as well as any trivial differences* between the obtained XML document and the second XML document that are made to avoid literal infringement. Thus, the specification provides a clear and definite standard for measuring the degree intended to be covered by the phrase "substantially similar."

The above-cited M.P.E.P. section teaches that a determination is made as to whether one of ordinary skill in the art, in view of the prior art and the status of the art, would be nevertheless reasonably apprised of the scope of the invention. Applicants submit that, given the disclosure of the present specification, the prior art, and the status of the art, those ordinarily skilled in the relevant art would be reasonably apprised of the scope of the invention.

Independent Claims

Independent claims 1, 10 and 24 were rejected under 35 U.S.C. §102(a) as being anticipated by Helgeson in view of Fernandez.

Claims 1 and 24

With regard to claim 1, for example, the Examiner asserts that Helgeson teaches a method for exporting at least a portion of a relational database to an XML document. Helgeson is

directed to methods and apparatus for managing data exchange among systems in a network.

With regards to claims 1 and 24, the Examiner asserts that Fernandez, column 2, lines 65-67, and col. 3, lines 23-54, disclose an “initial view query” that defines an XML view on a relational database. The Examiner further asserts that Helgeson, columns 49 and 73-74 disclose “modifying the initial view query to account for an effect of said at least one transformation (specified in an XSLT stylesheet).”

As indicated in Applicants’ prior responses, a “view query” specifies a *mapping between the relational tables and the resulting XML document*. Helgeson does not disclose or suggest view queries. Column 80, lines 51-55, of Helgeson merely discloses that an XML document can be created from a database. While Helgeson may use the term “view” in the presentation sense, Helgeson does not use the term “view query,” nor does Helgeson address using view queries to map between relational tables and a resulting XML document.

In addition, since Helgeson is not addressing “view queries,” Helgeson does not disclose or suggest “*modifying the initial view query* to account for an effect of said at least one transformation (specified in an XSLT stylesheet),” or “applying said modified view query to said relational database to obtain said XML document,” as further required by independent claims 1 and 24.

Likewise, Applicants can find no disclosure (and the Examiner has not alleged any) in Fernandez of “*modifying the initial view query* to account for an effect of said at least one transformation (specified in an XSLT stylesheet),” or “applying said modified view query to said relational database to obtain said XML document,” as further required by independent claims 1 and 24.

Fernandez merely teaches that an XML view can be specified by a query in a declarative query language of a middleware system. See, col. 3, lines 25-27. There is no disclosure or suggestion that this view query is modified at all, or especially, “to account for an effect of said at least one transformation.”

Thus, even as combined in the manner suggested by the Examiner Helgeson and Fernandez *do not teach every element of the independent claims*. Furthermore, based on the KSR considerations discussed hereinafter, the combination/modification suggested by the Examiner is not appropriate. Other than to allege that the motivation to combine is the desire to obtain the result (“in order to obtain an XML document according to the transformation specified by an XSLT stylesheet”), the Examiner has failed to establish “an apparent reason to combine ... known elements.” *KSR*

International Co v. Teleflex Inc (KSR), 550 U.S. ___, 82 USPQ2d 1385 (2007). Applicants query how this suggests an alleged combination to *modify the initial view query* to account for an effect of said at least one transformation (specified in an XLSI stylesheet),” or “applying said modified view query to said relational database to obtain said XML document.” As discussed below, this is insufficient to satisfy the Examiner’s burden of proof under *KSR*.

Applicants are claiming a new technique for exporting at least a portion of a relational database to an XML document **by** “*modifying the initial view query* to account for an effect of said at least one transformation (specified in an XLSI stylesheet),” and “applying said modified view query to said relational database **to obtain** said XML document.”

Initial view queries are not merely recited as an element of each claim, but rather the functional language requires that the initial view queries be modified to account for a transformation and then applied to a relational database to obtain the result. There is no suggestion in Helgeson or in Fernandez, alone or in combination, to modify initial view queries to account for a transformation and then applied to a relational database to obtain the result. In addition, there is absolutely no suggestion to modify the **views** (purely in the presentation sense) of Helgeson with the *initial view queries* of Fernandez.

Claim 10

With regards to claim 10, the Examiner again asserts that Helgeson discloses composing an XLSI stylesheet (citing col. 51, lines 32-34) and Fernandez discloses (with) an XML view on said relational database to produce said modified view query (citing column 2, lines 65-67, and col. 3, lines 23-54). Applicants can find no disclosure or suggestion in Fernandez of generating a modified view query. The passages referenced by the Examiner merely teach that an XML view can be specified by a query in a declarative query language of a middleware system. See, col. 3, lines 25-27. There is no disclosure or suggestion that this view query is **modified**. Claim 10 emphasizes that the modified view query is generated against a relational database to produce an XML document.

Applicants submit that the *KSR* considerations addressed above with regard to claims 1 and 24 are equally applicable to claim 10.

Applicants respectfully request the withdrawal of the rejection of independent claims 1, 10, and 24.

Dependent Claims

Claims 2-9, 11-18, 20-23 and 25-32 are dependent on independent claims 1, 10, 19 and 24, respectively, and are therefore patentably distinguished over each of the cited references, alone or in combination, because of their dependency from independent claims 1, 10, 19 and 24, for the reasons set forth above, as well as other elements these claims add in combination to their base claim.

Claims 4-5, 7, 12-14, 16, 21-22, 27-28 and 30 were indicated to be allowable if rewritten in independent form

All of the pending claims following entry of the amendments, i.e., claims 1-19 and 21-32, are in condition for allowance and such favorable action is earnestly solicited.

If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this application, the Examiner is invited to contact the undersigned at the telephone number indicated below.

The Examiner's attention to this matter is appreciated.

Respectfully,



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